



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,349	01/09/2006	Sarah C. Bodary Winter	P1988R1	4763
9157	7590	06/14/2007	EXAMINER	
GENENTECH, INC.			JIANG, DONG	
1 DNA WAY			ART UNIT	
SOUTH SAN FRANCISCO, CA 94080			PAPER NUMBER	
			1646	
			MAIL DATE	
			DELIVERY MODE	
			06/14/2007	
			PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,349	<b>Applicant(s)</b> BODARY WINTER ET AL.	
	<b>Examiner</b> Dong Jiang	<b>Art Unit</b> 1646	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, drawn to an isolated nucleic acid, a vector containing same, a host cell thereof, and a method of recombinantly producing the encoded polypeptide.

Group II, claim(s) 9-11, and 14-17 in part, drawn to an isolated polypeptide, a chimeric molecule thereof, an agonist thereof, and a composition and an article thereof.

Group III, claim(s) 12, 13, and 14-17 in part, drawn to an antibody to the polypeptide, and a composition and an article thereof.

Group IV, claim(s) 14-17 in part, drawn to an antagonist of the polypeptide, and a composition and an article thereof.

Group V, claim(s) 18 in part, drawn to a method of treating psoriasis by administering the polypeptide.

Group VI, claim(s) 18 in part, drawn to a method of treating psoriasis by administering an antagonist of the polypeptide.

Group VII, claim(s) 18 in part, drawn to a method of treating psoriasis by administering an antibody to the polypeptide.

Group VIII, claim(s) 19 and 21, drawn to a method for determining the presence of a PRO polypeptide in a sample, and a method of diagnosing psoriasis with an antibody.

Group IX, claim(s) 20, drawn to a method of diagnosing psoriasis by detecting the level of expression of a gene encoding the polypeptide.

Group X, claim(s) 22, drawn to a method of identifying a compound inhibiting the activity of the polypeptide.

Art Unit: 1646

Group XI, claim(s) 23 and 24, drawn to a method of identifying a compound inhibiting the expression of a gene encoding the polypeptide, wherein said candidate compound is an antisense nucleic acid.

Group XII, claim(s) 25, drawn to a method of identifying a compound mimicking the activity of the polypeptide.

The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Pursuant to 37 C.F.R., the main invention (Group I) in the instant application comprises the first-recited product, an isolated nucleic acid. Also included in this group are an expression vector comprising said nucleic acid, and a host cell thereof, and the first-recited method of using the product, namely a method of recombinantly producing the encoded polypeptide using the nucleic acid. Note that there is no method of making the nucleic acid. Although the polypeptide of Group II is encoded by the nucleic acid of the main invention, neither the nucleic acid nor the polypeptide encoded thereby is an advance over the prior art. For instance, Franke et al. (Proc. Natl. Acad. Sci. USA, 1989, 86:4027-31) discloses a nucleic acid, which encodes a human plakoglobin, wherein the nucleotide sequence of the nucleic acid (Figure 3) comprises the present SEQ ID NO:1 with 91.5% sequence identity; and the encoded polypeptide sequence of the human plakoglobin (Figure 3) is 100% identical to the present SEQ ID NO:2 (see computer printout of the search results). Thus, the Franke reference renders the present claim 1, among the other, not novel. As neither the polypeptide nor the encoding nucleic acid is novel, the technical feature of the peptide is not special, and the groups are not so linked by a single inventive concept under PCT Rule 13.1. The additional products in groups III and IV are physically and functionally distinct chemical entities, which share neither structure nor function with the product of the main invention. Therefore, they do not share a special technical feature with the main invention within the meaning of PCT Rule 13.2, and thus do not relate to a single invention concept within the meaning of PCT Rule 13.1. The additional methods of groups V-XII do not correspond to the main invention, as they are neither a method of making, nor a method of using said nucleic acid. Therefore, they are not considered to share a special technical feature with the

Art Unit: 1646

main invention within the meaning of PCT Rule 13.2, and thus do not relate to a single invention concept within the meaning of PCT Rule 13.1.

2. Furthermore, regardless of which Invention applicants elect above, further **restriction** is required under 35 U.S.C. 121 and 372:

A. Elect one specific polypeptide sequence with SEQ ID NO: from those recited in the claims, claim 1, for example.

The polypeptides with different SEQ ID NO as recited in the claims do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Each of SEQ ID NOs represents a unique and structurally distinct chemical entity, and the SEQ ID NOs are unrelated, each to each other. Therefore, they do not share a special technical feature within the meaning of PCT Rule 13.2 and thus do not relate to a single invention concept within the meaning of PCT Rule 13.1.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of the invention from Groups I-XII, and an election of the invention from Group A to be examined even though the requirement be traversed (37 CFR 1.143), and (ii) identification of the claims encompassing the elected invention. Applicant is advised that neither I-XII nor A is species election requirement; rather, each of I-XII and A is a restriction requirement.**

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In

Art Unit: 1646

either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

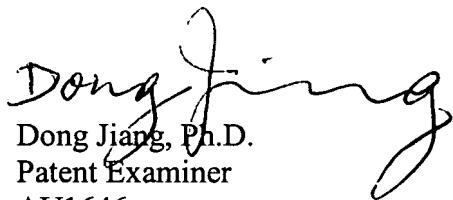
Art Unit: 1646

**Advisory Information**

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Dong Jiang, Ph.D.  
Patent Examiner  
AU1646

6/6/07